

IN THE CLAIMS

This listing of claims will replace all prior versions, and listings of claims in the application:

Listing of Claims:

Claim 1. (*Currently Amended*) A lockable ashtray for disposing of cigarette butts, comprising:

a dome shaped cover defining at least one unobstructed aperture therein;

wherein said dome shaped cover is substantially hemi-spherical, and said at least one unobstructed aperture is configured for the dropping of cigarette butts therethrough;

a lower section;

a hinge connecting said cover to said lower section, said cover being movable between a closed position and an open position;

a lock attached to said cover and said lower section; and

a tray disposed beneath said cover, said tray adapted to hold cigarette butts;

~~an inflammable~~ a nonflammable material, ~~said inflammable material~~ at least partially filling said tray;

said nonflammable material comprising sand;

wherein said cover hides cigarette butts from view, and said cover and said lock ~~preventing~~ prevent unauthorized access to the cigarette butts.

Claim 2. (*Canceled*)

Claim 3. (*Currently Amended*) The lockable ashtray according to claim 1, wherein said at least one aperture is circular; said aperture has a diameter between about 0.5" and 2".

Claim 4. (*Currently Amended*) The lockable ashtray according to claim 1, wherein said at least one aperture is circular; said aperture has a diameter between about 1" and 2".

Claim 5. (*Currently Amended*) The lockable ashtray according to claim 1, wherein said at least one aperture is circular; said aperture has a diameter of about 1".

Claim 6. (*Currently Amended*) The lockable ashtray according to claim 1, wherein said at least one aperture is a narrow elongated aperture; said aperture has a width between about 0.5" and 1".

Claims 7-9. (*Canceled*)

Claim 10. (*Previously Presented*) The lockable ashtray according to claim 1, wherein said lock is selected from the group consisting of a recessed lock and a padlock.

Claim 11. (*Canceled*)

Claim 12. (*Canceled*)

Claim 13. (*Previously Presented*) The lockable ashtray according to claim 1, wherein said lower section is adapted to be attached to a trashcan.

Claim 14. (*Previously Presented*) The lockable ashtray according to claim 1, wherein a chain attaches said lower section to a trashcan.

Claims 15-18. (*Canceled*)

Claim 19. (*Currently Amended*) A lockable ashtray for depositing and temporarily storing cigarette butts, comprising:

a cone shaped cover defining at least one aperture of circular dimensions between about 0.5" and 2" in diameter;

a cylinder shaped vessel having an inner lining defining an internal cavity at least partly filled with a bottom layer of immobile material and an upper layer of an ~~inflammable~~ a nonflammable material; and

a lock to reversibly secure said cover to said cylinder shaped vessel, whereby said lockable ashtray solves the problem of hiding cigarette butts from view while simultaneously inhibiting children or adults from gaining access to the ashtray.

Claim 20. (*Previously Presented*) The lockable ashtray according to claim 19, wherein said aperture has a diameter of about 1".

REMARKS/ARGUMENTS

By the present amendment, Applicant proposes to amend Claims 1 and 19 to correct an informality noted by the examiner, and amend Claims 3-6 to correct indefiniteness within these claims. Also, Applicant proposes to amend independent Claim 1 to better define Applicants' invention over the prior art references applied of record. In addition, Applicant proposes to cancel Claims 2, 7-9, 11, 12 and 15-18. Upon entry of the proposed amendment, independent Claim 1, with Claims 3-6, 10, 13 and 14 depending therefrom will remain for consideration. Previously allowed independent Claim 19, and Claim 20 depending therefrom, will remain as well.

The Examiner has objected to the disclosure, and to Claims 1, 12 and 19 for the use of the term "inflammable". The specification, claims and abstract have been corrected, and the objectionable term has been changed to -- nonflammable--, throughout.

In the recent Office action Claims 15-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Irmscher et al. (US 4,571,250). The cancellation of Claims 15-18 by the present amendment serves to render these particular grounds of rejection moot.

Claims 1, 3-6, 10 and 12-14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Irmscher et al. (US 4,571,250) in view of Kesinger et al (US 3,802,560). The indication by the Examiner that Claims 19 and 20 are allowable over the prior art of record is noted with appreciation.

Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

MPEP § 2143 states: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

With this as background, and since amended Claim 1 now includes the limitation previously found in dependent Claim 12, the Examiner's rejection of Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over Irmischer et al. (US 4,571,250) in view of Kesinger et al. (US 3,802,560) will be discussed. The Irmischer et al. device is to an ash-receiving container, which is used to hold ashes removed from a fireplace or wood stove. The ashes are dumped into the device, and the device is constructed so as to prevent ash dust from entering the room in which the fireplace or wood stove is located. The container 10 has a dome-shaped cover 24 pivotally attached to a lower section 16. Cover 24 has an aperture 48 disposed therein, with pipe 46 mounted in aperture 48. Pipe 46 connects flexible hose 45 to filter 41, as well as acts as the means of support for rendering chute 33

(Irmscher et al., col. 2, lines 58-60). An ash-receiving receptacle 19, or tray, is disposed beneath the cover and within the lower section 16. The patent to Irmscher et al. does not show; 1) a lock attached to the cover and the lower section, wherein the lock prevents unauthorized access into the device, 2) a nonflammable material at least partially filling the tray, wherein the nonflammable material is sand, and 3) at least one unobstructed aperture in the cover configured for the dropping of cigarette butts therethrough. The Kesinger et al. device is a self cleaning ash tray 10 which includes a bowl 20 for containing sand or other granular medium 22.

The Examiner believes that it would have been obvious to one of ordinary skill in the art to modify the ash container of Irmscher et al. by providing a lock between the cover 24 and lower section 16. The Examiner explains that “this limitation[s] is not deemed to patentably distinguish the claims from Irmscher et al. since it would have been obvious to one having ordinary skill in the art at the time of the invention to include a locking means, such as a conventional padlock or recessed lock, to prevent the inner receptacle from being stolen or taken”(Office action, p.3, lines 7-11). Applicants do not agree. It does not appear that Irmscher et al. is concerned with a problem of security, nor does it appear that he should be. There appears to be little chance of someone “stealing” or “taking” the inner receptacle 19 of the Irmscher et al. device as the Examiner would have us believe. A lock would be completely unnecessary, and thus unobvious on the Irmscher et al. ash container. In addition, Applicant has reviewed every reference of record in the present application and can find no teaching of a lock in any one of them. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior

art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). See MPEP § 2143.01.

The Examiner further believes that it would have been obvious to one of ordinary skill in the art to modify the ash container of Irmischer et al., in view of the teachings of Kesinger et al., by placing sand in the receptacle or tray 19 of Irmischer et al. since, “as explained in Kesinger et al, ash trays of the sand receptacle type are widely used because sand advantageously snuffs out cigar/cigarette butts almost immediately upon contact” (Office action, p. 4, lines 2-4, quoting from Kesinger et al., col. 1, lines 10-13). Again, Applicants are in disagreement with the Examiner. In this regard, the Irmischer et al. device is not to an ash tray for extinguishing cigarette and cigar butts, as described in the secondary reference to Kesinger et al., but to an ash receptacle for the cleaning of, and the removal of ashes from a wood stove or fireplace. There is nothing in either of these two references that would suggest to one of ordinary skill in the art, the desirability, and hence the obviousness of placing sand in the container of Irmischer et al. In fact, it would appear to be undesirable to do so, since the container or tray of Irmischer et al. will need to be lifted from the device and emptied once the container becomes filled with ashes.

Finally, independent claim 1 now recites that the at least one aperture in applicants’ cover be unobstructed, and that it is configured for the dropping of cigarette butts therethrough. Irmischer et al. shows an aperture 48 through cover 24, however, the aperture is not unobstructed since pipe 46 extends through the aperture. Nor, would it have been obvious to remove pipe 46, since it is integral to the operation of the device, and additionally provides support for rendering chute 33. If a proposed modification would render a prior

art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See MPEP § 2143.01. If the pipe 46 were to be removed, thus making the aperture 48 "unobstructed", the ash container device of Irmscher et al. would not operate as intended and bin 33 would be unsupported. Thus, there is no motivation for making such a modification.

The other references cited in the present application, but not relied upon by the Examiner in rejecting the claims, have also been carefully reviewed, however, Applicants find nothing therein which would overcome or supply that which is lacking in the basic combination of the applied prior art noted above.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). There is nothing in the teachings of the relied upon prior art references which would have suggested the desirability, and thus the obviousness of the Examiner's modifications of the ash container of Irmscher et al. Indeed, the lock is not even shown in any of the cited references. It is only by impermissible hindsight and reliance on Applicants' own disclosure that the Examiner would have been led to reconstruct the ash container of Irmscher et al. so as to derive Applicants' claimed lockable ashtray from the applied teachings. It is therefore Applicants' conclusion that the

combined teachings of Irmischer et al. and Kesinger et al. fail to establish a *prima facie* case of obviousness.

Applicant respectfully submits that the proposed amendments made herein properly respond to the outstanding Final Rejection and represent a *bona fide* effort to satisfactorily conclude the prosecution of this application. Care has been exercised to insure that no new matter has been introduced and that no new issues have been raised that would require further consideration or search. It is felt that no inordinate amount of time will be required on the part of the Examiner to review and consider this amendment. Applicant respectfully requests entry and favorable consideration of the proposed amendment. In the event that the application is not allowed, it is requested that this amendment be entered for purposes of appeal.

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Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Richard C. Litman", with a stylized flourish at the end.

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RCL/DHT:rwg